

**In the Drawings:**

The Examiner objected to the “conveter 114” label in Figures 7A, 7B, 8A and 8B. To address this issue, please replace Figures 7A, 7B, 8A, and 8B with the Replacement Sheets included herewith.

## REMARKS

Claims 1-48 remain pending in the application. Reconsideration of the present case is earnestly requested in light of the following remarks.

### Finality of the Office Action:

In the instant Office Action, the Examiner asserted a new ground of rejection for claims 1-48. Additionally, the Examiner asserted that the Information Disclosure Statement of January 23, 2006 prompted the new ground of rejection. However, Applicants note that the new reference, Dutta et al. (6,615,212, "Dutta") was not cited in the Information Disclosure Statement of January 23, 2006. As the Examiner is certainly aware, according to 706.07(a):

Under present practice, second or any subsequent actions on the merits shall be final, except where the Examiner introduces a new ground of rejection that is neither necessitated by Applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). See MPEP § 609.04(b)

Since the new ground of rejection was neither necessitated by amendment nor based on a referenced submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), **the finality of the present Action must be removed.**

### Section 103(a) Rejection:

The Examiner rejected claims 1-48 under 35 U.S.C. § 103(a) as being unpatentable over Mansour et al. (U.S. Publication 2002/0111995) (hereinafter "Mansour") in view of Dutta et al. (U.S. Patent 6,615,212) (hereinafter "Dutta"). Applicants respectfully traverse this rejection for at least the following reasons.

Regarding claim 1, contrary to the Examiner's assertion, Mansour in view of Dutta fails to teach or suggest that **the server is further configured to plug a converter**

**module into a framework configured to accept one or more pluggable modules, wherein the converter module is configured to generate a document in a small device format from one of the documents in one of the one or more server formats.** The Examiner admits that Mansour fails to disclose this feature of claim 1, and relies on Dutta for this teaching; however, Applicants assert that Dutta also fails to suggest the pluggable converter module recited in the claims. With regard to this feature, the Examiner states, “Dutta discloses the transcoding proxy server including a transcoding framework having transform plugin (Fig. 6) or transcoder plugin (Fig. 7)”. Applicants note that the transform plugin is mentioned only once in the entire specification Dutta (column 7, lines 50-53). More specifically, this portion discloses that the “transcoding framework 608 includes HTTP request transform plugin 610 for converting HTTP request 604 received from client 602 into a modified HTTP request 612 compatible with originating server 614, where the requested content is located”. Applicants assert that the transform plugin 610 is not configured to generate a document in a small device format from one of the documents in one of the one or more server formats as recited in the claims. Instead, the transform plugin of Dutta converts a HTTP request from the client to a modified HTTP request compatible with the server. Conversion of a HTTP request is not generation of a document in a small device format from one of the documents in one of the one or more server formats. One skilled in the art understands that requests are not documents. Thus, even if the teaching of Dutta were combined with those of Mansour, such a combination would clearly not result in Applicants’ claimed invention.

Additionally, the transcoder plugin cited by the Examiner also fails to teach the converter module recited in the claims. Applicant notes that the transcoder plugin is also mentioned only once (column 7, lines 58-62) in the entire specification of Dutta. This portion recites “transcoding framework 608 also includes XML to HTML transcoder plugin 704. XML to HTML transcoder plugin 704 converts server response 702 from XML data format to an HTML data format and sends HTML data 706 to client 602 for processing”. Thus, the transcoder plugin may convert a response to the HTTP request sent by the client back into a HTML format. In other words, the transcoder plugin and the transform plugin operate to convert requests and responses between the client and the server, e.g., from XML to HTML and vice versa. Clearly, the requests and responses that

are converted by the plugins in Dutta are not the generated documents in small device formats recited in the claims.

Additionally, the Examiner asserts, “the converter module (Dutta, the transcoder plugin) is configured to generate a document in a small device format (Dutta, client formats or PDF or HTML documents) from one of the documents in one of the one server format(s) (Dutta, postscript documents)” *[sic]*. **As noted above, contrary to the Examiner’s assertion, Dutta nowhere teaches that the transcoder plugin is configured to generate documents in a small device format;** instead, Dutta teaches that requests may be converted from HTML to HTML or from XML to HTML. Dutta nowhere mentions, suggests, *or even hints at* the transcoder plugin converting to or from postscript formats (e.g., PDF) or converting documents at all. Clearly, the Examiner has mischaracterized the teachings of Dutta; Dutta nowhere teaches or suggests the converter module recited in the claims. Furthermore, Applicants assert that Dutta nowhere teaches that the server is operable to plug the transform plugin or the transcoder plugin into a framework; instead, Dutta discloses that the transcoding framework already includes the transform and transcoder plugins. Thus, Mansour in view of Dutta fails to teach or suggest that *the server is further configured to plug a converter module into a framework configured to accept one or more pluggable modules, wherein the converter module is configured to generate a document in a small device format from one of the documents in one of the one or more server formats.*

**With further regard to claim 1, Applicants submit that the provided motivations to combine the Mansour and Dutta references are improper.** More specifically, the Examiner provided the following motivations from Mansour and Dutta:

for the purposes of making the display of the application data much more appropriate for the client device (Mansour, paragraph [0022]) or minimizing transmission times (Dutta, col. 2, lines 26-36).

Applicants assert that the provided motivations do not relate to the proposed combination. For example, in Mansour, “making the display of the application much more appropriate for the client device” refers the benefits provided by the UI structured

provided by Mansour. There is no need whatsoever to include the transcoder plugin of Dutta to achieve this presumed benefit. Additionally, as argued above, the transcoder plugin of Dutta is directed towards conversion of requests and responses between the server and the client. Clearly, Mansour is capable of handling communication between the server and client without this plugin; Mansour nowhere indicates the desirability of this feature. The motivation cited in Dutta “minimizing transmission times”, which relates to the speed at which data may be transcoded, does not imply or suggest any reason to make the specification combination proposed by the Examiner. Instead, this minimization of transmission times indicates the presumed benefits of using the invention disclosed by Dutta. Applicants remind the Examiner that, as held by the U.S. Court of Appeals for the Federal Circuit in *Ecolchem Inc. v. Southern California Edison Co.*, an obviousness claim that lacks evidence of a suggestion or motivation for one of skill in the art to combine prior art references to produce the claimed invention is defective as hindsight analysis. In addition, the showing of a suggestion, teaching, or motivation to combine prior teachings “must be clear and particular . . . . Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence’.” *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999). The art must fairly teach or suggest to one to make the specific combination as claimed. That one achieves an improved result by making such a combination is no more than hindsight without an initial suggestion to make the combination. For at least the reasons above, Applicants assert that the Examiner has failed to provide a proper suggestion to combine the two references Mansour and Dutta. Additionally, even were the two references properly combinable, which Applicants argue they are not, they would still fail to teach or suggest the invention as claimed. For at least the reasons above, the rejection of claim 1, and those claims dependent therefrom, is not supported by the cited art and removal thereof is respectfully requested.

With regard to claim 3, Mansour in view of Dutta fails to disclose **wherein the converter module is further configured to exclude one or more format features of the document in the server format from the document in the small device format.** Regarding this claim, the Examiner cites paragraph [0217] and paragraphs [0053]-[0218]

of Mansour as well as column 2, lines 38-58 and column 7, line 13-column 9, line 26 of Dutta. Applicants assert that paragraph [0217] discloses how a user may interact with a client device to launch various server applications over the Internet. As an example, a portion of paragraph [0217] recites:

For example, the end user can establish a connection with the TA server 2404, enter login data, launch and terminate server-based applications, switch between server-based applications, manipulate action controls rendered on the user interface 2412, manipulate display controls rendered on the user interface 2412, enter and edit data items associated with the user interface 2412, and perform other operations via the user interface 2412.

Clearly, this is irrelevant with respect to the recited feature of claim 3 above. Nowhere in this paragraph, nor anywhere else, does Mansour teach exclusion of format features of the document as recited in claim 3. Regarding the citation of paragraphs [0053]-[0218], Applicant reminds the Examiner that, according to the MPEP 706, “The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity”. Additionally, 37 CFR 1.104 states:

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Applicant therefore requests that the Examiner more particularly point out which section of Mansour teaches this feature of claim 3 and provide a clear explanation of the rejection. **Applicant notes that the Examiner has failed to provide any response whatsoever in response to the above arguments.**

With further regard to claim 3, the cited portions of Dutta (as well as any other portion of Dutta) fails to teach or suggest the pluggable converter module excluding format features of the document. Instead, the cited portions of Dutta teach the method by which the server and client communicate information and documents. There is no mention of the exclusion of format features, as recited in the claims, by Dutta. Additionally, the Examiner has failed to provide any arguments whatsoever regarding the

teaching of Dutta and Mansour; instead, the Examiner merely cites portions of Mansour and Dutta that have already been cited and fails to provide any explanation of the citations at all. Clearly, the Examiner has not designated the particular part relied upon nor clearly explained the pertinence of each reference for this claim as required by 37 CFR 1.104.

For at least the reasons above, the rejection of claim 3, and those claims dependent therefrom, is not supported by the prior art and removal thereof is respectfully requested. Independent claims 16, 29, and 42 include similar limitations as claim 1, and so the above arguments apply with equal force to claims 16, 29, and 42. Furthermore, as shown above in regard to claim 3, the cited art does not disclose excluding one or more format features of the office document from the small device document. Thus, for at least the reasons provided above, the rejection of claims 16, 29, and 42, and those claims dependent therefrom, is not supported by the prior art and removal thereof is respectfully requested.

Applicants also assert that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

## CONCLUSION

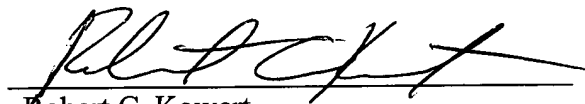
Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-10600/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Replacement Sheets
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☐ Other:

Respectfully submitted,

  
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